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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/680,435

10/08/2003

Yasuyuki Nakagawa

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22428

7590

09/24/2004

FOLEY AND LARDNER

SUITE 500

3000 K STREET NW

WASHINGTON, DC 20007

EXAMINER

COURSON, TANIA C

ART UNIT

PAPER NUMBER

2859

DATE MAILED: 09/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/680,435

Applicant(s)

NAKAGAWA ET AL.

Examiner

Tania C. Courson

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2859

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 08OCT03.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Specification

1. A substitute specification is required pursuant to 37 CFR 1.125(a) because the specification is replete with improper idiomatic English.

A substitute specification must not contain new matter. The substitute specification must be submitted with markings showing all the changes relative to the immediate prior version of the specification of record. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived. An accompanying clean version (without markings) and a statement that the substitute specification contains no new matter must also be supplied. Numbering the paragraphs of the specification of record is not considered a change that must be shown.

A substitute specification in proper idiomatic English and in compliance with 37 CFR 1.52(a) and (b) is required. The substitute specification filed must be accompanied by a statement that it contains no new matter.

Claim Objections

2. Claims 1, 3, 5 and 9 are objected to because of the following informalities:

- a) claim 1, in line 19, “a back end” should read “said back end”;

- b) claim 3, in line 6, “a light emitting portion of a tip edge” should read “said light emitting portion of said tip edge”;
- c) claim 5, in line 1, “5,” should read “5.”;
- d) claim 9, in line 5, “a harness” should read “said harness”.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-6 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors. Furthermore, claim 1 states “mountain shape” and claim 5 states “floating state”, a clear and specific geometric term is required in order to properly describe the instrument.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-4 are rejected under 35 U.S.C. 102(e) as being anticipated by Nakagawa et al. (US 6,585,385 B2).

Nakagawa et al. discloses in Figures 1-4, an automotive display structure comprising:

- a) a plate having a surface on which characters are provided (Fig. 3, board 25), an outer periphery wall member of a cylinder shape for surrounding a periphery of said plate on the surface side (Fig. 3, cylinder casing), a transparent cover which is supported by said outer periphery wall member with a space from said plate (Fig. 3, transparent cover 42), wherein said transparent cover is formed with a mountain shape in section so as to reflect an outside light toward an inside face of said outer periphery wall member (Fig. 3), and said outer periphery wall member is formed by a transparent material having the similar quality of material with said transparent cover (Fig. 3), wherein, a light emitting portion is formed in a tip edge portion of the outer periphery wall member by disposing concealing means in side faces of the outer periphery wall member (Fig. 3, inside wall 27B and case 45), an illumination light from a light source which is disposed in a back end of edge portion side of said outer periphery wall member (Fig. 3, light source 35), and a foot portion of said transparent cover of

the mountain shape in section is connected to a back end of edge portion of said outer periphery wall member (Fig. 3);

- b) wherein the concealing means provided on the side faces of said outer periphery wall member is constructed by an internal cylinder member and an external cylinder member, and said outer periphery wall member is contained between the internal cylinder member and the external cylinder member (Fig. 3, inside wall 27B and case 45);
- c) wherein a light emitting ring member in which an inner periphery face and an outer periphery face of the light emitting ring member is adopted to become the same faces with an inner periphery face of the internal cylinder member and an outer periphery face of the external cylinder member is disposed in a light emitting portion of a tip edge portion of said outer periphery wall member separately from the internal cylinder member and the external cylinder member (Fig. 3, inside wall 27B and case 45);
- d) wherein said light emitting ring member includes a metallic gloss (Fig. 3, case 45), and a surface treatment of thin layer which is capable of transmitting an illumination light is applied to the light emitting ring member (Fig. 3, transparent inside wall 27B).

7. Claims 5-7 and 9 are rejected under 35 U.S.C. 102(e) as being anticipated by Sugiyama et al. (US 2003/0116079 A1).

Sugiyama et al. discloses in Figures 1-16, a vehicle display structure comprising:

- a) a plate having a surface on which characters are provided (Fig. 8, dial plate 121), an indicating needle which is disposed rotatably along the surface of the plate (Fig. 8, needle), a transparent cover which is disposed separately from the plate in the surface side of the plate (Fig. 8, LCD panel 102), wherein a small display section is provided in said transparent cover so as to become a floating state to the plate (Fig. 8, indication of LCD panel 102a);
- b) said small display portion is disposed in a position which is overlapped with a base portion of said indicating needle of transparent cover (Fig. 8);
- c) wherein said small display portion is contained in a housing (Fig. 8, backlight unit 103), and an outside face of the housing and a base portion of said indicating needle are arranged approximately concentrically (Fig. 8), or the outside face of said housing is constructed to have a larger diameter than the base portion of the indicating needle (Fig. 8);
- d) wherein a passage hole which lets through a harness for supplying power to said small display portion is disposed in a base portion of said indicating needle (specification, paragraphs 126-129), and the passage hole is adopted as a non-interference shape in which a harness does not interfere to a rotation of the indicating needle (specification, paragraphs 126-129).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sugiyama et al. Sugiyama et al. disclose a vehicle display structure, as stated above in paragraph 7. Sugiyama et al. do not disclose wherein an outside face of a housing of a small display portion is extended as a taper shape tapering interiorly as approaching to a plate.

With respect to claim 8: the shape of a housing of a small display, i.e., tapering interiorly, absent any criticality, are only considered to be obvious modifications of the shape of the housing of a small display (Fig. 8, backlight unit 103) disclosed by Sugiyama et al. as the courts have held that a change in shape or configuration, without any criticality, is within the level of skill in the art as the particular shape claimed by Applicant is nothing more than one of numerous shapes that a person having ordinary skill in the art will find obvious to provide using routine experimentation based on its suitability for the intended use of the invention. See *In re Dailey*, 149 USPQ 47 (CCPA 1976). Therefore, one skilled in the art would change the shape of the housing of the small display in order to suit the needs of the user of the device.

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Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The prior art cited on PTO-892 and not mentioned above disclose a display device for a vehicle:

Sato et al. (US D491,504S)

Furuya (US 2003/0121467 A1)

Olbrich (US 6,601,532 B1)

Brandt (US 6,522,391 B1)

Noll et al. (US 6,511,194 B1)

Niwa (US 6,334,688 B1)

Greene (US 3,699,915)

Braswell (US 2,158,925)

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tania C. Courson whose telephone number is (571) 272-2239.

The examiner can normally be reached on Monday-Friday from 8:00AM to 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego Gutierrez, can be reached on (571) 272-2245.


The fax number for this Organization where this application or proceeding is assigned is (703) 872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DIEGO F.F. GUTIERREZ
SUPERVISORY PATENT EXAMINER
GROUP ART UNIT 2859

TCC
September 17, 2004


G. BRADLEY BENNETT
PRIMARY EXAMINER
AU 2859